

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted today via the Office electronic filing system in accordance with 37 CFR §1.6 (a)(4).

Date: January 24, 2010 Signature: /Sarah L. Ryan/

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/787,302 Confirmation No. 6560
Applicant : RAO, Padakandla Krishna
Filed : February 27, 2004
TC/A.U. : 2618
Examiner : NGUYEN, Tuan Hoang

Docket No. : 52404-317
Customer No. : 89415

Commissioner for Patents
Alexandria, VA 22313-1450
U.S.A.

Dear Sir:

PETITION FOR PATENT TERM ADJUSTMENT

In accordance with 37 CFR 1.705(d), Applicant requests reconsideration of the patent term adjustment indicated on the cover page of the Letters Patent. The fee set forth in 37 C.F.R. 1.18 (e) has been submitted concurrently herewith.

Patent Term Adjustment and Grounds Thereof

Applicant has calculated the patent term adjustment to be 1753 days, which is greater than the 1584 days of patent term adjustment indicated on the cover page of the Letters Patent. The grounds for this patent term adjustment include the USPTO's failure to take certain actions within specified time frames as set out in 37 C.F.R. 1.702 (a), the USPTO's failure to issue a patent within three years of the actual filing date of the application as set out in 37 C.F.R. 1.702 (b), and Applicant's reasonable efforts to conclude prosecution of the application. Details of Applicant's calculation of patent term adjustment, including the relevant dates involved, are provided below.

Relevant Prosecution Dates

The following is a timeline of various correspondences during prosecution of this application along with their respective dates. Applicant's calculation for delays is also listed.

| <u>Event</u> | <u>Date</u> | <u>PTO Delay</u> | <u>Appl Delay</u> |
|----------------------|--------------------|------------------|-------------------|
| Application filed | February 27, 2004 | | |
| IDS filed | February 27, 2004 | | |
| IDS filed | September 27, 2004 | | |
| IDS filed | July 14, 2005 | | |
| IDS filed | August 9, 2006 | | |
| Non-Final Action | August 28, 2006 | 488 | |
| Response filed | November 15, 2006 | | |
| Final Rejection | February 26, 2007 | | |
| Response filed | April 16, 2007 | | |
| Advisory Action | June 13, 2007 | | |
| Notice of Appeal | August 13, 2007 | | |
| Request Pre-Appeal | August 13, 2007 | | |
| IDS filed | January 4, 2008 | | |
| Prosecution Reopened | January 22, 2008 | | |
| Non-Final Action | April 2, 2008 | 230 | |
| Response filed | June 27, 2008 | | |
| IDS filed | August 26, 2008 | | 60 |
| Non-Final Action | October 9, 2008 | | |
| Response filed | January 5, 2009 | | |
| Non-Final Action | March 17, 2009 | | |
| Response filed | June 17, 2009 | | |
| Non-Final Action | September 4, 2009 | | |
| Response filed | December 4, 2009 | | |
| Non-Final Action | January 19, 2010 | | |
| Response filed | April 13, 2010 | | |
| IDS filed | May 20, 2010 | | 37 |
| Notice of Allowance | July 16, 2010 | | |
| Issue Fee | October 18, 2010 | | 0 |
| Patent Issued | November 23, 2010 | 1132 | |

Having regard to the timeline above, Applicant provides details of patent term adjustment due to examination delay as set out in 37 C.F.R. 1.703, together with details of reduction of patent term adjustment as set out in 37 C.F.R. 1.704.

Patent Term Adjustment due to Examination Delay

37 C.F.R. 1.703 (a) stipulates that the patent term adjustment includes “the number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.” Having regard to the timeline set out above, it can be seen that a delay started on February 27, 2004 + 14 months + 1 day = April 28, 2005. This delay ended when the 1st Office Action issued on August 28, 2006, which is a delay of 488 days (hereinafter referred to as “1st A-delay”).

37 C.F.R. 1.703 (a) stipulates that the patent term adjustment includes “the number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.” Having regard to the timeline set out above, it is noted that Applicant filed a reply to a Final Rejection on April 16, 2007. A decision to withdraw the Final Rejection later issued and a Non-Final Rejection subsequently issued on April 2, 2008. Therefore, a delay started on April 16, 2007 + four months + 1 day = August 17, 2007. This delay ended when the Non-Final Rejection issued on April 2, 2008, which is a delay of 230 days (hereinafter referred to as “2nd A-delay”).

37 C.F.R. 1.703 (b) stipulates that the patent term adjustment includes “the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a)”. Having regard to the timeline set out above, it can be seen that a delay started on February 27, 2004 + three years + 1 day = February 28, 2007. This delay ended when the application issued to patent on November 23, 2010, which is a delay of 1365 days. 37 C.F.R. 1.703 (b) also stipulates that the patent term adjustment does not include “the number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first,

if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.” Therefore, the delay does not include the days from the filing of the Notice of Appeal on August 13, 2007 and the issuance of the Non-Final Action on April 2, 2008, which is a time period of 233 days. Therefore, the delay includes 1365 days - 233 days = 1132 days (hereinafter “B-delay”).

It is believed that 37 C.F.R. 1.703 (c), 37 C.F.R. 1.703 (d), and 37 C.F.R. 1.703 (e) are not relevant for calculating patent term adjustment in the present case.

37 C.F.R. 1.703 (f) states that “the term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704.” Since the 1st A-delay ended on August 28, 2006 (i.e. when the 1st Office Action issued) and the B-delay started later on February 28, 2007 (i.e. after three years of pendency), the 1st A-delay and the B-delay do not overlap¹. Also, since the 2nd A-delay started on August 17, 2007 and ended on April 2, 2008, and the B-delay does not include the time period from August 13, 2007 to April 2, 2008, the 2nd A-delay and the B-delay do not overlap. For at least these reasons, Applicant submits that none of the A-delays overlap with the B-delay and therefore the patent term adjustment is 488 days + 230 days + 1132 days = 1850 days, less the sum of the periods calculated under 37 C.F.R. 1.704.

No Terminal Disclaimer

In accordance with 37 C.F.R. 1.705 (2)(iii), Applicant confirms that the present case is not subject to a terminal disclaimer and is therefore entitled to patent term adjustment.

Reduction of Patent Term Adjustment

37 C.F.R. 1.704 stipulates that “submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the

1 Note that the recent decision in *Wyeth v. Kappos* (Fed. Cir. 2010) confirms that A-delays do not overlap with B-delays during the first three years of pendency.

supplemental reply or other such paper was filed.” Having regard to the timeline set out above, it can be seen that filing an Information Disclosure Statement on August 26, 2008 introduced a first Applicant delay because this was done so after a response was filed on June 27, 2008, which is a delay of 60 days. Additionally, filing an Information Disclosure Statement on May 20, 2010 introduced a second Applicant delay because this was done so after a response was filed on April 13, 2010, which is a delay of 37 days.

37 C.F.R. 1.704 stipulates that “the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.” Whilst the issue fee was paid on October 18, 2010, which is two days plus three months after the Notice of Allowance issued on July 16, 2010, Applicant submits that this does not mean that Applicant failed to engage in reasonable efforts to conclude processing of the application. Since the Notice of Allowance issued on July 16, 2010, the deadline to pay the issue fee was October 16, 2010 (i.e. Saturday). 35 U.S.C. § 21(b) stipulates that “when the day, or the last day, for ... paying any fee ... falls on Saturday, Sunday, or a Federal holiday ... the fee [may be] paid, on the next succeeding secular or business day.” In this case, the issue fee was timely paid on the next business day on October 18, 2010 (i.e. Monday). As such, Applicant timely paid the fee in accordance with 35 U.S.C. § 21(b) and therefore did engage in reasonable efforts to conclude prosecution of the application.

For at least these reasons, Applicant submits that patent term adjustment should be reduced by no more than 60 days + 37 days = 97 days.

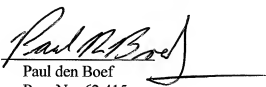
Accordingly, the patent term adjustment is 1850 days – 97 days = 1753 days.

Conclusion

Applicant is entitled to a patent term adjustment of at least 1753 days as calculated herein above.

Respectfully submitted,

RAO, PADAKANDLA KRISHNA

By 
Paul den Boef
Reg. No. 62,415
Tel.: 613.232.2486

PDB

Date: January 24, 2010